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September 14, 2005

Mail Stop –Appeal Brief Patents, Commissioner for Patents
P.O. Box 1450
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RE: Docket No. K-1775D

In the application of: Montgomery, Jr.

Serial No.10/657,397 Filed: September 8, 2003

For: MANUALLY REPLACEABLE PROTECTIVE WEAR SLEEVE

Certificate of Mailing (37 CFR 1.8(a))

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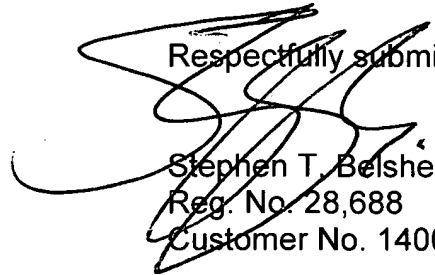
Sir:

Transmitted herewith in triplicate in the above appeal is applicant's:

REPLY BRIEF TO EXAMINER'S ANSWER OF JULY 19, 2005.

If any fees are necessary to enter the above-identified paper, please charge such fees to Deposit Account 02-2267. A duplicate of this paper is enclosed herewith.

Respectfully submitted,


Stephen T. Belshiem
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Customer No. 1400

Enclosures



K-1775D
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the application of: Montgomery, Jr.)
Serial No.10/657,397) GROUP ART UNIT 3673
Filed: September 8, 2003) Examiner: Singh, Sunil
For: MANUALLY REPLACEABLE
PROTECTIVE WEAR SLEEVE

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Date: **September 14, 2005**

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Sir: **REPLY BRIEF TO EXAMINER'S ANSWER OF JULY 19, 2005**

INTRODUCTION

This Reply Brief is being filed within two (2) months of the mailing of the Examiner's Answer and thus is timely filed in this appeal.

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DISCUSSION

Introduction

Throughout the Examiner's Answer, the Examiner reiterates that there is no structure in applicant's claims that is any different from the sleeve in Peterson et al. See the Examiner's Answer at page 4, lines 11-13; page 5, lines 9-11; page 6, lines 9-11 and page 7, lines 4-6. Applicant respectfully submits that the Examiner's position is in error because Peterson et al. (including the disclosure of the sleeve (35)) does not anticipate the claims, and especially claim 22, since each and every claim limitation is not found, either expressly or inherently, in Peterson et al. See MPEP 2131 (Rev. 2 May 2004) page 2100-73.

The Examiner's Admission

At page 5, lines 3-7 of the Examiner's Answer, the Examiner admits that the last recitation in claim 22 must be given patentable weight¹ in the patentability analysis when the Examiner writes:

Even though the later recitation of "... when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder" breathes life and meaning to the claim, the fact remains that such phrases is still intended use.

The Requirements for Peterson et al. to Anticipate

In order for Peterson et al. to anticipate claim 22, it must, either expressly or inherently, disclose the last limitation in claim 22 that reads:

¹ It also appears that the Examiner's admission means that the preamble must be given patentable weight.

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... when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder.

Peterson et al. Does Not Contain an Express Disclosure of the Limitation

This radial outward bias limitation is more than a statement of intended use, but defines a property of the sleeve in terms of interaction with the bore of the holder. There is no express disclosure in Peterson et al. of this radial outward bias limitation. This will become very apparent in light of the discussion below about the lack of any inherent disclosure in Peterson et al. of the radial outward bias limitation.

Peterson et al. Does Not Contain an Inherent Disclosure of the Limitation

The Examiner relies upon an inherent teaching in Peterson et al. to address the above-recited outward radial bias limitation from claim 22. However, as discussed at MPEP 2112 IV (Rev. 2 May 2004 pages 2100-54 and 55), it is not an easy task for the Examiner to establish the existence of a limitation via inherency because it takes more than to show that a certain result or characteristic may occur or be present in the prior art. See In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Instead, to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities so that the mere fact that a certain thing may result from a given set of circumstances is not sufficient. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied

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prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

What this means in this case is that the Examiner must be able to prove that the radial outward bias limitation necessarily flows from or is necessarily present in the teachings in Peterson et al. The Examiner has not made this proof since probabilities or possibilities are not sufficient to establish that Peterson et al. inherently possesses the outward radial bias limitation.

When considering whether Peterson et. al. discloses a sleeve that meets the radial bias limitation, one cannot ignore the fact that Peterson et. al. pertains to an abrasive surface treatment apparatus that has different sets of removable abrasive blocks. See Column 1, lines 6-9. The overall apparatus of Peterson et al. impacts the disclosure based upon the sleeve (35), which is a small component of the overall apparatus.

The disclosure of Peterson et al. does not suggest that the sleeve (35) or any part of the sleeve (35) possesses any resilience that would permit it to exhibit an outward radial bias.

For example, the Peterson et al. sleeve (35) serves the purpose of providing a flange (37) surface whereby a coil spring (45) is retained between the flange (37) and an enlarged head of a pin (41) that contains an abrasive material. The coil spring (45) biases the pin (41) downward away from the sleeve (35). See Column 3, line 65 through Column 4, line 7.

The sleeve is intended to "fit comfortably" in the recess (31) so that it does not engage the surface of the recess (31). See Column 3, line 65 through Column 4, line 1. There is no teaching in Peterson et al. that the sleeve (35) has any

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resilience or needs any resilience in order to properly function in the abrasive floor treatment apparatus of Peterson et al.

Furthermore, there is no teaching in Peterson et al. that the sleeve has any resilience in a radial inward direction with respect to the pin (41) that is received by the central bore (39) of the sleeve since the sleeve is sized to comfortably receive the shaft of the pin. See Column 4, lines 2-5. There is no requirement that the sleeve needs any resilience to properly function vis-à-vis the pin (41). It should be appreciated that the slot (51) in the sleeve (35) functions to permit a roll pin (47) to pass into a hole (49) in the pin (41). See Column 4, lines 5-11. The slot (51) does not need to provide, and there is no suggestion that it provides, any resilience to the sleeve (35).

Finally, the sleeves (35) are held in the recesses through the tightening of screws (55). Tightening the screws reduces the size of the slot (53) so that the sleeves are clamped in place. See Column 4, lines 12-22. Here, there is no disclosure about any resilience to the sleeves and there is no requirement that the sleeves exhibit resilience in order to be clamped in place.

A review of the entire disclosure, including the sleeve, of Peterson et al. shows that there is an absence of any disclosure that the sleeve possesses any resilience, and it is a fact that some resilience is necessary to achieve the radial outward bias limitation. To argue that the sleeve of Peterson et al. meets the radial outward bias limitation is speculative, and at best, comprises a possibility or a probability which are insufficient to establish inherency. See MPEP 2112 (Rev. 2 May 2004), pages 2100-53 through 55.

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CONCLUSION

The Examiner has not established that Peterson et al. discloses (either expressly or inherently) the radial outward bias limitation. Appellant respectfully submits that claims 22-25 are patentable over Peterson et al. Appellant solicits the reversal of this rejection and a remand to the patent examiner with instructions to allow the claims.

Respectfully submitted,


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Date: September 14, 2005